

Serial No. 10/056,312

Amendment in Resp. to Fin. Office Action of Oct. 21, 2003

UTILITY PATENT

B&amp;D No. TN-1488

**REMARKS**

Applicants would like to extend their sincere thanks to the Examiner for conducting a telephone interview on October 23, 2003, where the Examiner explained the arguments presented in the Office Action to Applicants' attorney. The following remarks address the issues raised during such interview.

Applicants have amended Claim 1. Applicants have also canceled Claims 3-24. Persons skilled in the art should recognize that such claims were canceled because they related to unelected inventions, and that no disclaimer is intended by such cancellation. Applicants intend to file such canceled Claims in a future continuation application.

Currently pending therefore in the present application are Claims 1-2.

The Examiner has rejected Claims 1-2 under 35 USC § 103(a) as being unpatentable over the prior art disclosed on page 1, lines 7-20, of the Specification ("the Described Prior Art") in view of US Patent No. 5,393,270 ("Grobelaar"). Reconsideration and withdrawal of this rejection is respectfully requested.

Claim 1, as amended, calls for a miter saw comprising a base assembly, a rotatable table rotatably connected to the base assembly and having a plane, a saw assembly including a motor, and a blade disposed on an arbor, the arbor having a first gear, an intermediate gear meshing with the first gear, and a second gear driven by the motor and meshing with the intermediate gear,

Serial No. 10/056,312

Amendment in Resp. to Fin. Office Action of Oct. 21, 2003

UTILITY PATENT

B&amp;D No. TN -1488

wherein the intermediate gear is always meshing with the first and second gears, and a pivot arm pivotally attached to the table and supporting the saw assembly.

Admittedly, the Described Prior Art discloses all elements called for in Claim 1 except for the intermediate gear, which meshes with the first and second gears. Applicants have amended Claim 1 to explicitly state that the previously claimed "idler gear" is just an intermediate gear, rather than an idler gear that can be moved between an engaged position and a disengaged position in order to provide an idling mode which allows the user to "disengage a motor driven implement without having to turn the motor on and off," as suggested by the Examiner.<sup>1</sup>

The Examiner may rely on Grobbelaar to provide the disclosure for such intermediate gear. However, the Examiner should not do this because no motivation or suggestion to combine the Described Prior Art with Grobbelaar exists.

According to MPEP § 2142, to establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142, at 2100-121. In the present case, there is no teaching or suggestion in the Described Prior Art to add the Grobbelaar idler gear, as suggested by the Examiner.

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<sup>1</sup> This amendment is only intended as a clarification of what was already present in the previously-claimed "idler gear." Accordingly, this should not be interpreted as a narrowing amendment that disclaims any subject matter. Indeed, Applicants do not intend such a disclaimer.

Serial No. 10/056,312

Amendment in Resp. to Fin. Office Action of Oct. 21, 2003

UTILITY PATENT

B&amp;D No. TN-1488

Similarly, there is no teaching or suggestion in Grobbelaar to add an idler gear to a miter saw built according to the Described Prior Art.

Furthermore, no suggestion to combine or modify the Described Prior Art with Grobbelaar exists because such modification would render the Described Prior Art unsatisfactory for its intended purpose. "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01, at 2100-124 (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

The Examiner argues that a person would have combined the Described Prior Art and Grobbelaar "in order to provide a safety mechanism, such as an idling mode of operation for the saw, to disengage the turning of the blade while the motor is turning." However, such rationale is incorrect. Most, if not all, miter saws are not provided with any such idling modes. Indeed, the miter saw presently incorporating the claimed invention does not have any such idling mode.

Having such idling mode would lower the cutting efficiency of the miter saw, as the blade would stop turning if it gets jammed into wood. This would render the miter saw of the Described Prior Art unsatisfactory for its intended purpose, i.e., cutting wood. Because the Examiner's proposed combination would be unsatisfactory for its intended purpose, no suggestion or motivation exists to make the proposed modification. Therefore, the obviousness rejection is improper under MPEP § 2143.

Serial No. 10/056,312

Amendment in Resp. to Fin. Office Action of Oct. 21, 2003

UTILITY PATENT

B&amp;D No. TN-1488

Furthermore, the claimed invention has clear advantages over the prior art. Because of the intermediate gear, the transmission between the motor and the blade can be modified to increase cutting capacity. This is evidenced by comparing the cutting capacity of the miter saws respectively built according to the Described Prior Art and to the claimed invention.

The assignee manufactures and sells the DeWalt DW705 and DW706 miter saws. The DW705 is built according to the Described Prior Art, whereas the DW706 is built according to the claimed invention, respectively. Both miter saws have a 12-inch blade.

The top vertical cutting capacity of the DW705 (the miter saw according to the Described Prior Art) when cutting baseboard against the miter saw's fence is 4.25 inches. The top vertical cutting capacity of the DW706 (the miter saw according to the claimed invention) when cutting baseboard against the miter saw's fence is 6 inches. That's an increase in cutting capacity of more than 41% over the prior art miter saw, even though the blade size is the same.

Similarly, the top vertical cutting capacity of the DW705 (the miter saw according to the Described Prior Art) when cutting vertically-nested crown molding is 5.25 inches. The top vertical cutting capacity of the DW706 (the miter saw according to the claimed invention) when cutting vertically-nested crown molding is 6.625 inches. That's an increase in cutting capacity of more than 26% over the prior art miter saw, even though the blade size is the same.

Such enormous increases are obtained by the use of an intermediate gear in the transmission, which allows the designers to open a pocket to provide increased clearance, as

Serial No. 10/056,312

Amendment in Resp. to Fin. Office Action of Oct. 21, 2003

UTILITY PATENT

B&D No. TN -1488

described in page 11 of the Specification. Such increased clearance translates into substantial increases in cutting capacity.

Because neither the Described Prior Art nor Grobbelaar teach or suggest such advantageous arrangement, they cannot render Claims 1-2 unpatentable.

No fee is believed due. Nevertheless, the Commissioner is authorized to charge payment of any other fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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